

REMARKS

Applicant concurrently files herewith a Petition for Extension of Time, and corresponding extension of time fee, for a one-month extension of time.

Claims 1-5 and 7-18 are pending in this application. Claims 1-5, 7, and 8 have been amended to more particularly define the claimed invention. Claims 9-18 have been added to claim additional features of the invention and to provide more varied protection for the claimed invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1 and 2 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as being anticipated by Groswith, III et al. (U.S. Patent No. 5,163,350; hereinafter “Groswith”).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as exemplarily defined by claim 1) is directed to an information outflow prevention punch.

The information outflow prevention punch includes an operation part that is longitudinally long, a punch blade group including two or more punch blades forming a column in a longitudinal direction in the operation part, a rotation axis running at a right angle to a direction of the column of the punch blades and provided in a front end side of the operation

part, a top base supporting the rotation axis in the front end side, a bottom base fixed to the top base in a rear end side and forming an insertion slot for a punch material in conjunction with the top base, and a lifting mechanism for lifting the punch blade group. The operation part rotates up and down with the rotation axis as a fulcrum, in that neighboring n-th punch blade and (n+1)-th punch blade of the punch blade group are provided close to such a degree that information written on the punch material cannot be identified, and in that a punch material is inserted from the insertion slot at the front edge side of the operation part and the rear end of the operation part is pushed down to lower the punch blade group to punch a plurality of holes in the punch material for preventing information outflow (e.g., see Application at Figure 2 and page 13, line 11 through page 17, line 2). The claimed invention provides an information outflow prevention punch that allows a user to easily punch holes in the address portion or magnetically recorded portion of mail to prevent a third party from reading the information (e.g., see Application at page 3, lines 1-8).

II. THE INDEFINITENESS REJECTION

The Examiner alleges that claims 1 and 2 are indefinite. Specifically, the Examiner alleges that the phrase “to lower said punch blade group from above said top base” is indefinite.

Applicant submits that the phrase “from above said top base” has been deleted from the claims.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTION

The Examiner alleges that Groswith teaches the claimed invention of claims 1 and 2. Applicant submits, however, that there are features of the claimed invention that are neither taught nor suggested by Groswith.

That is, Groswith does not teach or suggest "*a lifting mechanism for lifting said punch blade group*", as recited in claim 1.

Groswith merely teaches an operation member 37, which lowers a punch blade 26 through a die plate 25 (see Groswith at Figure 2). The operation member 37 also lifts the punch blade up from the die plate 25. Groswith, however, does not teach or suggest a separate lifting mechanism that lifts the punch blade group (what the Examiner refers to as reference numerals 26 and 31 in Groswith).

The claimed invention, however, includes an operation part (e.g., 1), which lowers the punch blade group (e.g., 2) and a lifting mechanism (e.g., 3), which lifts/urges that punch blade group (e.g., 2) upward (e.g., see Application at Figure 2).

This feature is not taught or suggested by Groswith.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. NEW CLAIMS

New claims 9-18 have been added to claim additional features of the invention and to provide more varied protection for the claimed invention. These claims are independently patentable because of the novel and non-obvious features recited therein.

Applicants submit that new claims 9-18 are patentable over any combination of the cited references at least based on similar reasons to those set forth above with respect to

claims 1-5, 7, and 8.

V. FORMAL MATTERS AND CONCLUSION

In accordance with the Examiner's objection, Applicant submits herewith a newly executed oath, which is compliance with 37 C.F.R. § 1.67(a).

In view of the foregoing, Applicant submits that claims 1-5 and 7-18, all of the pending claims, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: October 4, 2007

Respectfully Submitted,



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 21254